

REMARKS

The above-identified patent application has been reviewed in light of the Examiner's Action dated February 28, 2007. No Claims have been amended or canceled. Claims 26-27 are new. Accordingly, Claims 1-7, 9-13, 15-17 and 19-27 are now pending. As set forth herein, reconsideration and withdrawal of the rejections of the claims are respectfully requested.

Initially, the undersigned would like to thank the Examiner for the courtesies extended during telephone conferences held on March 9, 2007 and on March 12, 2007. During those telephone conferences, the undersigned presented distinctions between the claimed invention and the cited references. Such distinctions are further discussed in these remarks. Proposed new claims 27, in the form presented with this Amendment and Response, were also discussed. In addition, exemplary diagrams comprising details of the figures submitted with the original application and which are included in the Remarks section of this Amendment and Response, were discussed. No agreement regarding allowable subject matter was reached.

During the telephone conference held on March 12, 2007, the Examiner suggested the possibility that a printed matter rejection could be made to the claimed invention, and suggested that the undersigned review *In re Gulak*, 217 U.S.P.Q. 401 (Fed. Cir. 1983) and *In re Miller*, 164 U.S.P.Q. 46 (C.C.P.A. 1969). From the undersigned's review of these decisions, it is apparent that a printed matter rejection would be entirely inappropriate in connection with the pending claims. As stated by the court in *Gulak*: "Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." (*Gulak* at 403). Indeed, the facts of *Gulak* can be considered instructive in the present application. In that case, the applicant sought to patent a device comprising an endless band imprinted in a particular manner. Notably, the Board of Appeals reversed the examiner's rejection of the claims as not directed to statutory subject matter under 35 U.S.C. §101, finding that the claims defined an article of manufacture. However, the Board of Appeals affirmed a rejection of the claims as unpatentable under 35 U.S.C. §103. The Court of

Appeals for the Federal Circuit reversed the Board's and the Examiner's rejections under 35 U.S.C. §103, finding that the imprinted digits were functionally related to the band, and that the cited reference failed to disclose or suggest the subject matter of the appealed claims. (*Gulack* at 405).

Claims 26 and 27 are new. These new claims recite subject matter that is not taught, suggested or described by any of the cited references. For example, Claim 26 recites first and second panels. A first partial portion of a first letter is formed on the surface of the first panel, such that it extends to the bottom edge of the first panel. A second partial portion of that first letter is formed on the surface of the second panel such that it extends to the top edge of the second panel. In addition, it is specified that together, the first and second panels comprise all of the first letter. The claim further recites a readerboard, with the first panel placed in a first row of the readerboard and the second panel is placed in the second row of the readerboard, such that the sides of the first and second panels are aligned with one another. As a result, a portion of the first character is obscured by tracks of the readerboard. In particular, as recited by the claim, the top channel of the first track receives the bottom edge of the first panel and obscures some of the first partial portion of the letter, and the bottom panel of the first track receives the top edge of the second panel and obscures some of the second partial portion of the letter. This arrangement is illustrated in Fig. A below, which represents a detail taken from Fig. 10 of the Application as originally filed. In particular, Fig. A illustrates the character "A" in the word "sandwich" in Fig. 10.

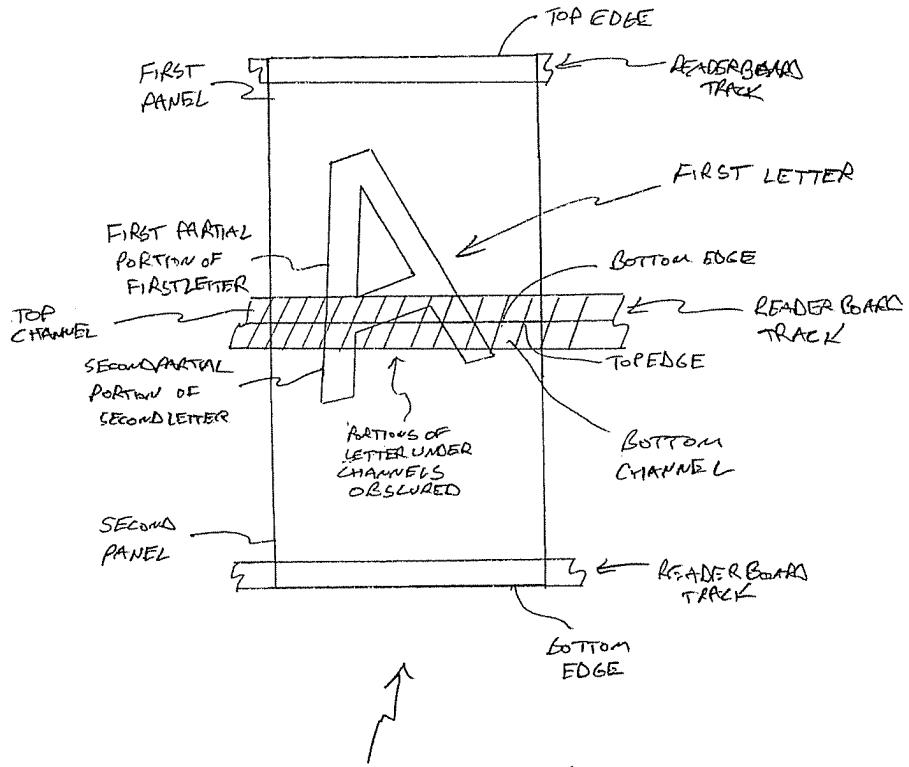
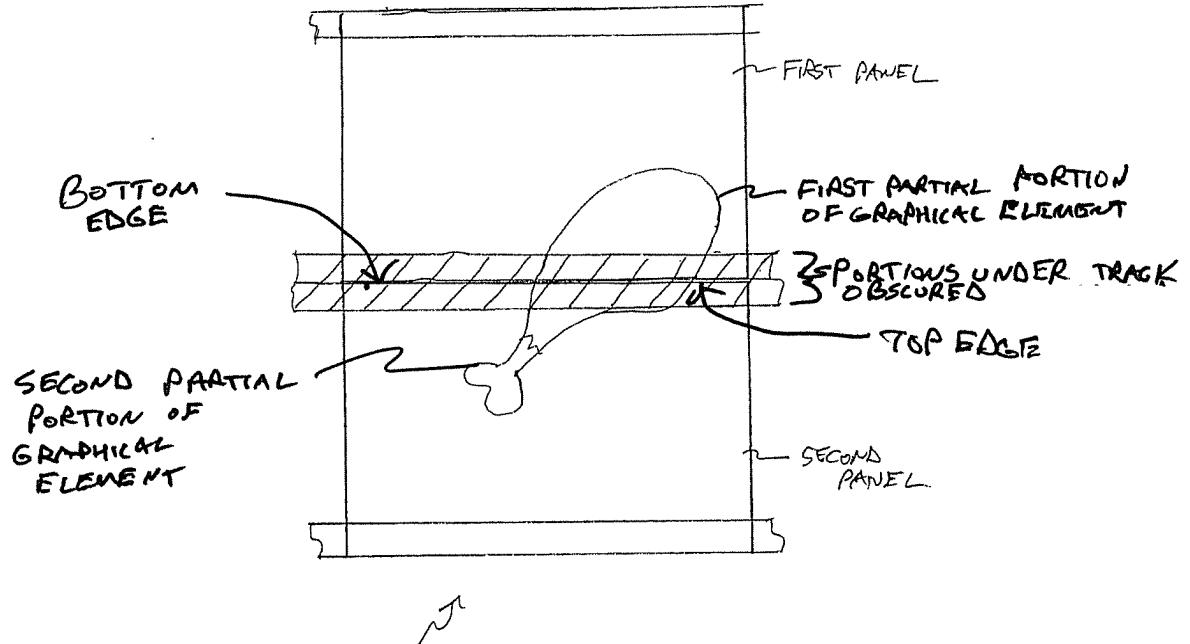


FIG. 10 DETAIL (SINGLE LETTER ON MULTIPLE PANELS - claim 26)

Claim 27 recites first and second panels on which first and second partial portions of a graphical element are formed. More particularly, a first partial portion of the graphical element is formed on the surface of the first panel and extends to the bottom edge of the first panel, and the second partial portion of the graphical element is formed on the second panel and extends to the top edge of the second panel. The claim further recites a readerboard with a plurality of tracks forming rows that receive panels. More particularly, the first panel is placed in the first row and the second panel is placed in the second row such that the first partial portion of the first graphical element on the first panel is aligned with the second partial portion of the first graphical element on the second panel. The claim further recites that the top channel of the first track receives the bottom edge of the first panel and obscures some of the first partial portion of the graphical element, and the bottom channel of the first track receives the top edge of the second panel and obscures some of the second partial portion of the graphical element.

The claim further specifies that the graphical element is not a letter or a word. An example of a readerboard system displaying a first graphical element as recited by Claim 27 is shown in Fig. B below, which represents a detail of a drumstick displayed in the example of Fig. 8 of the patent application as originally filed.



Accordingly, each and every element of the claims, including new claims 26 and 27, are not taught, suggested or described by the cited references.

Claims 1-7, 9-13, 15-17 and 19-25 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6, 216,375 to Griffin ("Griffin") in view of U.S. Patent No. 4,035,940 to Mickey et al ("Mickey"). However, it is submitted that each and every element of the claims rejected as obvious can not be found in the cited references whether those references are considered alone or in combination. In particular, the cited references do not teach, suggest, or disclose a system in which a complete graphical image or letter is formed using multiple panels that each contain a partial portion of the complete image or word, and that are held in the tracks of a conventional readerboard

such that a portion of the displayed image is obscured, as claimed. Accordingly, the rejections under 35 U.S.C. §103 should be reconsidered and withdraw.

The Griffin reference is cited for disclosing a conventional readerboard with panels that can be used to display messages. As noted in the Office Action, the top and bottom edges of the panels of Griffin that engage the tracks are not displayed to the viewer. The panels of Griffin are "character plates 23" that are provided with an alpha-numeric character. However, it should be noted that the portions of the panels of Griffin that are not displayed are blank. Accordingly, Griffin does not teach, suggest or describe a system in areas corresponding to a track of a readerboard in which a portion of an overall message or graphic is not displayed because it's obscured by the track of the readerboard. Instead, Griffin discusses a conventional readerboard system in which complete textual characters or graphic images are displayed by simple panels. Moreover, Griffin does not teach, suggest or describe displaying complementary portions of a unitary graphic image or of a single textual character on adjacent panels. Although Griffin does show the spelling of complete words using individual letter panels, no portions of the individual letters or complete words are obscured by a track of a readerboard.

The Mickey reference also does not teach, suggest or describe a system in which a portion of an overall message or graphic is not displayed in areas corresponding to a track of a readerboard because it is obscured by the track of the readerboard. Instead, Mickey is another example of the conventional use of a readerboard to spell out complete words using letters that are each completely formed on a single panel. For example, the word "sign" shown in Fig. 1 of Mickey is formed by placing individual panels containing the individual letters of the complete word in different rows of a readerboard. There is no disclosure in Mickey of using multiple panels to form single characters. In addition, no portion of the characters is obscured by a track of the readerboard. Accordingly, even if the disclosure of Mickey were combined with that of Griffin, the resulting combination would not teach, suggest or describe each and every element of the pending claims.

With respect to Claim 1, it can be appreciated that the cited references do not teach, suggest or disclose first and second semiotic element that combine to form said at least a portion of the substantially continuous message comprising at least one of a textual character and a graphic image is formed without discontinuities when said first and second panel elements are registered with one another separate from the readerboard with the bottom edge of the first panel element and the top edge of the second panel element butted against one another. Instead, the cited references discuss the use of panels that each contain a complete letter. In addition, the cited references do not teach a system in which portions of the substantially continuous message are obscured. Accordingly, for at least these reasons, the rejections of Claims 1-6, 20, 22, 24 and 25 as obvious should be reconsidered and withdrawn.

Claim 7 recites a method of advertising in which a message is distributed across a plurality of panel elements such that first and second panel elements contain first and second complementary semiotic elements. The claim further recites placing the first and second panel elements in a readerboard in a first relationship to one another to display a message. A portion of the first semiotic element adjacent the bottom edge of the first panel element is obscured by a first channel of a first one of the tracks of the readerboard. A portion of the second semiotic element adjacent a top edge of the second panel element is obscured by a second channel of the first one of the tracks of the readerboard. These features are not present in the cited references. Instead, the Griffin reference teaches the use of conventional readerboard letters or panels, and is not cited against these unique features of the present invention. The Mickey reference also discusses conventional panels that each contains a complete character. Accordingly, the references do not teach, suggest or describe a semiotic element extending across two panels that is partially obscured by a channel of a readerboard. Therefore, for at least these reasons, the rejections of Claims 7, and 9-11 should be reconsidered and withdrawn.

With respect to Claim 12, the cited references do not teach, suggest or disclose a graphic image or a letter that is completely formed on first and second panel elements. In addition, those references do not teach, suggest or describe a portion of the graphic image

or letter that is obscured by the track of a readerboard. Accordingly, for at least these reasons, the rejections of Claims 12-13, 15-17, 19 and 21 as obvious should be reconsidered and withdrawn.

As set forth above, each and every element of the pending claims has not been taught, suggested or described by the cited prior art references. Accordingly, it is submitted that a *prima facie* case of obviousness has not been established. (MPEP Section 2143.03.) However, even if a *prima facie* case of obviousness had been established by the Office Action, there is substantial evidence showing that the claimed invention is in fact not obvious. For example, the present invention has enjoyed considerable commercial success, has been copied by others, and provides unexpected results. In addition, the invention was initially met with skepticism. This evidence of non-obviousness is set forth in the application as originally filed and in the declaration under 37 C.F.R. §1.132 by Patrick Case, which is submitted herewith.

With respect to the commercial success of the invention, Mr. Case in his declaration provides facts illustrating that yearly sales of the claimed system have been significant, and have increased dramatically each year that the system has been sold. In addition, Mr. Case's declaration demonstrates copying by others once they have learned of the claimed system, either from Mr. Case directly, or from observing the claimed invention in use. Mr. Case also demonstrates in his declaration the skepticism with which the system is initially viewed by those of ordinary skill in the art, and the subsequent acceptance of the claimed invention after those who initially viewed it with skepticism have used the invention. Moreover, unexpected results provided by the invention are illustrated, as the lines across the larger graphic elements or images that result from use of the claimed system unexpectedly detract very little from a viewer's appreciation of the overall graphical element or image. Mr. Case also demonstrates that the various features and advantages of the claimed invention result from the claimed features. For example, Mr. Case's declaration presents evidence that the system provides an economical and reliable way to present relatively large displays using a conventional readerboard. More particularly, these advantages are the result of the use of multiple

panels that are sized such that they can be produced using conventional equipment, are easily handled during installation and storage, and are resistant to being blown out of a readerboard by high winds, as compared to the large span-over panels that would otherwise be necessary to present comparable graphical elements or images. Therefore, in view of the evidence of non-obviousness, the rejections of the claims should be reconsidered and withdrawn.

As set forth both above, the Specification has been amended to correct a typographical error. No new matter has been added by this amendment.

The application is now appearing to be in form for allowance, early notification of same is respectfully requested. The Examiner is invited to contact the undersigned if doing so would expedite prosecution or allowance of the application.

Respectfully submitted,

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